UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,435	03/08/2000	J. Andrew Goossen	MFCP.68661	1997

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MICROSOFT CORPORATION
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EXAMINER
BOUTAH, ALINA A

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr>
<td rowspan="2">Office Action Summary</td>
<td colspan="2">Application No.
09/520,435</td>
<td colspan="2">Applicant(s)
GOOSSEN ET AL.</td>
</tr>
<tr>
<td colspan="2">Examiner
Alina N Boutah</td>
<td>Art Unit
2143</td>
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</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 August 2006</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7-11,13,14,26-32 and 35-47* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,7-11,13,14,26-32 and 35-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

This action is in response to the Applicant's amendment received August 31, 2006.

Claims 1-4, 7-11, 13-14, 26-32 and 35-47 are currently pending in the present application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on August 31, 2006 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 7-11, 13-14, 26-32 and 35-47 are provisionally rejected under the judicially

created doctrine of obviousness-type double patenting as being unpatentable over claim 1-46 of

copending Application No. 10/997,450. Although the conflicting claims are not identical, they

are not patentably distinct from each other because they claim substantially the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-14 and 35-44 are rejected under 35 U.S.C. 101 because the claimed invention

is directed to non-statutory subject matter.

Claims 13-14 and 35-44 are not limited to tangible embodiments. In view of Applicant's

disclosure, specification page 8, line 7 through page 9, line 5, the medium is not limited to

tangible embodiments, instead being defined as including both tangible embodiments (e.g.,

RAM, ROM, EEPROM, flash memory, etc.) and intangible embodiments (e.g., program

modules and data signal such as a carrier wave, acoustic, RF, infrared and other wireless media).

As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Further, claims 35-44, which recite "data structure", are also non-statutory for at least the

reason that it is not tangibly embodied in a manner so as to be executable. Further, a collection

of fields, per se, is not an actual data structure, instead being non-functional descriptive material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

Claims 1-4, 7, 8, 10, 13, 14, 26-31, 35-43 are rejected under 35 U.S.C. 103(a) as being

unpatentable over USPN 6,538,758 issued to Ikegawa in view of USPN 6,707,948 issued to

Cosman.

Regarding claim 1, Ikegawa teaches a method in a computer system for transferring a

compressed data file from a software application running within the computer system to a printer

in communication with the computer system, said method comprising:

receiving a request to transfer a compressed data file to the printer from the software

application (col. 12, lines 27-49);

determining whether the printer is configured to decompress the compressed data file

(col. 12, lines 27-49);

if the printer is configured to decompress the compressed data file, obtaining the

compressed data file from the software application (col. 12, lines 27-49).

However, Ikegawa does not explicitly teach performing coordinate transformations to the

data file and transferring the data file to the printer.

In an analogous art, Cosman teaches performing coordinate transformations to a data file

(abstract; col. 13, lines 17-28). At the time the invention was made, one of ordinary skill in the

art would have been motivated perform coordinate transformation to a data file in order to resize the file so that it will be more suitable for the printer's capability, thus providing faster printing and better printing quality (abstract).

Regarding claim 2, Ikegawa teaches the method as recited in claim 1, wherein said receiving a request to transfer a compressed data file includes receiving a data structure from the software application, the data structure containing an indication of a classification of the compressed data file format and a pointer to the compressed data file (col. 12, lines 27-49).

Regarding claim 3, Ikegawa teaches the method as recited in claim 1, wherein said determining whether the printer is configured to decompress the compressed data file further comprises: obtaining a device file decompression configuration data structure, the data structure containing data indicative of compressed data file formats supported by the printer; and
    determining whether the file decompression configuration data structure indicates whether the printer is configured to decompress the compressed data file (col. 12, lines 27-49).

Regarding claim 4, Ikegawa teaches the method as recited in claim 1, wherein said determining whether the printer is configured to decompress the compressed data file includes:
    passing a compressed data file pointer to the device; and receiving an indication whether the device is configured to decompress the compressed data file (col. 12, lines 27-49).

Regarding claim 7, Ikegawa teaches the method as recited in claim 1, wherein the compressed data file is a compressed data image (col. 13, lines 7-14).

Regarding claim 8, Ikegawa teaches the method as recited in claim 7, wherein the compressed data image file is a JPEG image (col. 13, lines 7-14).

Regarding claim 10, Ikegawa teaches the method as recited in claim 1 further comprising receiving an uncompressed data file from the software application if the printer is not configured to receive the compressed data file (col. 13, lines 7-14)

Regarding claim 13, Ikegawa teaches one or more computer-readable media having computer-executable components comprising:

(a) a device support query component that, when executed, determines whether a printer is configured to decompress a compressed data file associated with an application (col. 12, lines 27-49);

(b) an application interface component that, when executed, receives the compressed data file from the application (col. 12, lines 27-49); and

(c) a device interface component for transferring the compressed data file to the printer (col. 12, lines 27-49).

However, Ikegawa does not explicitly teach performing coordinate transformations to the data file and transferring the data file to the printer.

Cosmos teaches performing coordinate transformations to a data file (abstract; col. 13, lines 17-28). At the time the invention was made, one of ordinary skill in the art would have been motivated perform coordinate transformation to a data file in order to resize the file so that it will be more suitable for the printer's capability, thus providing faster printing and better printing quality (abstract).

Regarding claim 14, Ikegawa teaches one or more computer-readable media of claim 13, wherein said application interface component further comprises a compressed data file information transformation component that, when executed, manipulates data within the compressed data file (col. 12, lines 27-49).

Regarding claim 26, Ikegawa teaches a method in a computer system for transferring a compressed data file from a software application running within the computer system to a printer in communication with the computer system, said method comprising:

requesting a determination whether the printer is configured to decompress the compressed data file (col. 12, lines 27-49);

receiving a response whether the printer is so configured (col. 12, lines 27-49); and

if the printer is configured to decompress the compressed data file, transferring the compressed data file to the device (col. 12, lines 27-49).

However, Ikegawa does not explicitly teach performing coordinate transformations to the data file and transferring the data file to the printer.

Cosmos teaches performing coordinate transformations to a data file (abstract; col. 13, lines 17-28). At the time the invention was made, one of ordinary skill in the art would have been motivated perform coordinate transformation to a data file in order to resize the file so that it will be more suitable for the printer's capability, thus providing faster printing and better printing quality (abstract).

Regarding claim 27, Ikegawa teaches the method as recited in claim 26, wherein said requesting includes passing a pointer to the compressed data file and a indication of a type of compressed data file to the computer system (col. 11, lines 52-54).

Regarding claim 28, Ikegawa teaches the method as recited in claim 26, wherein said transferring includes passing the compressed data file to the printer via a data structure (col. 11, lines 52-54).

Regarding claim 30, Ikegawa teaches the method as recited in claim 26, wherein the compressed data file is a compressed data image file (col. 13, lines 7-14).

Regarding claim 31, Ikegawa teaches the method as recited in claim 30, wherein the compressed data image file is a JPEG compressed data image file (col. 13, lines 7-14).

Regarding claim 35, Ikegawa teaches one or more computer-readable media having stored thereon a data structure, comprising:

(a) a first field containing data indicating a classification of a compressed data file (figure 15; col. 12, lines 27-49);

(b) a second field data indicative of a property of the compressed data file (figure 15; col. 12, lines 27-49); and

(c) data indicative of whether a printer is configured to decompress the compressed data file, wherein if the third field indicates that a printer is configured to decompress the compressed data file (figure 15; col. 12, lines 27-49).

However, Ikegawa does not explicitly teach performing coordinate transformations to the data file and transferring the data file to the printer.

Cosmos teaches performing coordinate transformations to a data file (abstract; col. 13, lines 17-28). At the time the invention was made, one of ordinary skill in the art would have been motivated perform coordinate transformation to a data file in order to resize the file so that it will be more suitable for the printer's capability, thus providing faster printing and better printing quality (abstract).

Cosmos teaches performing coordinate transformations to a data file (abstract; col. 13, lines 17-28). At the time the invention was made, one of ordinary skill in the art would have been motivated perform coordinate transformation to a data file in order to resize the file so that it will be more suitable for the printer's capability, thus providing faster printing and better printing quality (abstract).

Regarding claim 36, Ikegawa teaches the data structure recited in claim 35, wherein the

first field includes data indicating an escape function identifying the classification of the

compressed data file (col. 12, lines 27-49).

Regarding claim 37, Ikegawa teaches the data structure recited in claim 35, wherein the

first field includes a numeral identifying the classification of the compressed data file (col. 12,

lines 27-49).

Regarding claim 38, Ikegawa teaches the data structure recited in claim 35, wherein the

second field includes a pointer to a compressed data file stored in a memory (figure 15).

Regarding claim 39, although Ikegawa does not expressly teaches the data structure

recited in claim 35, wherein the second field includes an address to a compressed data file, by the

principle of inherency, in a data packet, there is a field that must include an address for

identification purposes.

Regarding claim 40, although Ikegawa does not expressly teach the data structure recited

in claim 35, wherein the second field includes a copy of the compressed data file, in order to

deliver the data, a copy of the file must be inherently included in the packet.

Regarding claim 41, Ikegawa teaches the data structure recited in claim 35, wherein the third field includes a numeral indicative of whether the device is configured to decompress the compressed data file (col. 12, lines 27-49).

Regarding claim 42, Ikegawa teaches the data structure recited in claim 35, wherein the compressed data file is a compressed data image file (col. 13, lines 7-14).

Regarding claim 43, Ikegawa teaches the data structure recited in claim 42, wherein the compressed data image file is a JPEG compressed data image file (col. 13, lines 7-14).

Claims 9, 32 and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikegawa in view of Cosman, in further view of Applicants' admitted prior art.

Regarding claims 9, 32 and 44, Ikegawa fails to explicitly teach the compressed data image file as recited in claims 7, 30, and 42, respectively, as being a PNG compressed data image file. Applicant's admitted prior art teaches conventional devices capable of receiving and processing compressed data files such as JPEG and PNG (Specification, page 1, lines 10-11). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to support PNG compressed data image file expand the capability of the transferring of the compressed data from a software application to a device.

Regarding claim 45, Ikegawa teaches a method in a computer system for rendering a

compressed data file on a printer in communication with a computer system, said method

comprising:

receiving a request to send a compressed data file to the printer (col. 12, lines 27-49);

determining whether the printer is configured to decompress the compressed data file

(col. 12, lines 27-49); and

if the printer is configured to decompress the compressed data file, sending the

compressed data file to the printer (col. 12, lines 27-49).

However, Ikegawa does not explicitly teach performing coordinate transformations to the

data file.

Cosmos teaches performing coordinate transformations to a data file (abstract; col. 13,

lines 17-28). At the time the invention was made, one of ordinary skill in the art would have been

motivated perform coordinate transformation to a data file in order to resize the file so that it will

be more suitable for the printer's capability, thus providing faster printing and better printing

quality (abstract).

Applicant's admitted prior art teaches decompressing the compressed data file and

transferring the uncompressed data file to a peripheral device if the device is not configured to

decompress the compressed data file (Specification, page 1, line 22 to page 2, line 23; page 19,

lines 5-7). At the time the invention was made, one of ordinary skill in the art would have been

motivated to incorporate the teaching of Applicant's admitted prior art into the teaching of

Ikegawa and Cosman in order to ensure that the receiving printer will receive a data no matter what.

Regarding claim 46, Ikegawa teaches the method as recited in claim 45, wherein receiving said request includes receiving a data structure from the software application, the data structure containing an indication of a type of the compressed data file and a pointer to the compressed data file (col. 12, lines 27-29).

Regarding claim 47, Ikegawa teaches the method as recited in claim 46, wherein said determining whether the printer is configured to decompress the compressed data file further comprises:

obtaining a decompressed-configured data structure, the data structure containing data indicative of compressed-data-file formats supported by the device (col. 12, lines 27-49); and

determining whether the file decompressing-configuration data structure indicates whether the printer is configured to decompress the compressed data file (col. 12, lines 27-49).

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.
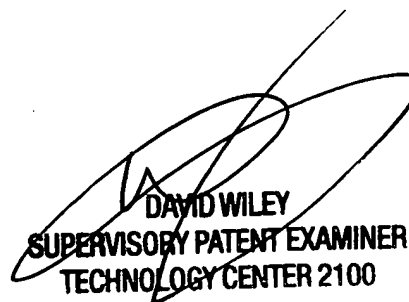
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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